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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/034,528	12/27/2001	Benjamin N. Eldridge	P6C3-US	2563
50905	7590	03/04/2009		
N. KENNETH BURRASTON KIRTON & MCCONKIE P.O. BOX 45120 SALT LAKE CITY, UT 84145-0120			EXAMINER PATEL, PARESH H	
			ART UNIT 2829	PAPER NUMBER
			NOTIFICATION DATE 03/04/2009	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/034,528	Applicant(s) ELDRIDGE ET AL.	
	Examiner Paresh Patel	Art Unit 2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 43,48,49,51-57,59-65,74-81 and 93-111 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 43,48,49,51-57,59-65,74-81 and 93-111 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>08/08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 11/10/2008 have been fully considered but they are not persuasive. With respect to Godshalk reference, the Applicants' argues that the scrub marks on the terminals of a semiconductor device produced by Godshalk's process will not be as **uniform** across the device as the scrub marks in the terminals of the tested semiconductor device of claim 43, because Godshalk lacks "adjusting a planar orientation of probe elements of a probe card assembly to corresponding to a planar orientation of said electrical contact terminals by changing a planar orientation of a probe substrate to which said probe elements are attached with respect to a probe card of said probe card assembly." Examiner disagrees with Applicants because Godshalk discloses scrub marks are **substantially uniform** as recited at claims 108 and 109. Independent claim 43 does not include "substantially uniform" limitation. Later, on pages 11-14 of the Remarks, Applicants' illustrated a drawings fig. A-C to explain the non-uniform and uniform scrub marks across the semiconductor device. Illustration as explained does help understand the importance of the process step, however **determination of patentability is based on the product itself, And Godshalk discloses the claimed product.**

Specification

2. The amendment filed 07/05/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: in claims 108-109, "the scrub marks are substantially uniform".

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 43, 48-49, 51-57, 59-65, 74-81 and 93-111 are rejected under 35 U.S.C. 102(b) as anticipated by Godshalk et al. (US Pat. 5,506,515).

Regarding claims 43, 108 and 109, Godshalk et al. (hereafter Godshalk) **in fig. 2-3** discloses a tested semiconductor device **[chip of wafer 24]** comprising electrical contact terminals and scrub marks on ones of the electrical contact terminals produced by a process comprising:

providing a wafer **[24]** having a plurality of semiconductor devices **[chips]** thereon, each of said semiconductor devices including a plurality of electrical contact terminals **[pads of chips]**;

adjusting a planar orientation of probe elements of a probe card assembly to correspond to a planar orientation of said electrical contact terminals by changing a planar orientation of a probe substrate to which said probe elements are attached with respect to a probe card of said probe card assembly, a compliant electrical connection flexing to maintain electrical connections between electrical contacts on said probe card of said probe card assembly and said probe substrate,

effecting contact between ones of said electrical contact terminals of ones of said semiconductor devices and ones of said probe elements, said contact causing said ones of said probe elements to be pressed with a contact force against and to wipe across **[lines 25-37 of column 15]** said ones of said contact terminals of said ones of said semiconductor devices and thereby make scrub marks (substantially uniform for claims 108 and 109) **[see fig. 2-3 for uniform pressure of probes/fingers]** on at least a plurality of said terminals of a first of said ones of said semiconductor devices; and

testing **[using 20, see fig. 1]** said ones of said semiconductor devices **[regarding the process limitations in a product claim, pursuant to MPEP 21113, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of the product does not depend on its method of production. In this case, tested semiconductor device of Godshalk comprises electrical contact terminals and substantially uniform scrub marks, and method of making does not change the end product].**

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wherein said first of said ones of said semiconductor devices is said tested semiconductor device.

Regarding claims 48-49, 51-57, 59-65, 74-81, 93-107 and 110-111, which either directly or indirectly depends from claim 43, are also rejected because Godshalk discloses said tested semiconductor device.

4. Claims 43, 48-49, 51-57, 59-65, 74-81 and 93-111 are rejected under 35 U.S.C. 102(b) as being anticipated by Wood et al. (US 5539324).

Regarding claims 43, 108 and 109 Wood et al. (hereafter Wood) discloses a tested semiconductor device **[die]** of a wafer **[30]** comprising electrical contact terminals and substantially uniform scrub marks on ones of the electrical contact terminal, **As further recited. Regarding the process limitations in a product claim, pursuant to MPEP 2113, even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of the product does not depend on its method of production. In this case, tested semiconductor device of Wood comprises electrical contact terminals and substantially uniform scrub marks, and method of making does not change the end product.**

Regarding claims 48-49, 51-57, 59-65, 74-81, 93-107 and 110-111, which either directly or indirectly depends from claim 43, are also rejected because Wood discloses said tested semiconductor device.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paresh Patel whose telephone number is 571-272-1968. The examiner can normally be reached on 8:00 to 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ha Nguyen can be reached on 571-272-1678. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paresh Patel/
Primary Examiner, Art Unit 2829

February 26, 2009